

REMARKS

I. Status of Claims

Claims 1-58 are pending in the instant case. All the pending claims stand subject to the restriction requirement.

II. Restriction.

The Office Action requires restriction of pending claims 1-58 to one of the following sixteen groups:

Group I, claims 1-6, drawn to a compound (alcohol) of a formula, classified in class 568.

Group II, claims 7-12, drawn to compound (ester) of a formula, classified in class 558 with several subclasses.

Group III, claims 13-16, drawn to a compound (epoxide) of a formula, classified in class 549 with several subclasses.

Group IV, claims 17 and 20-22, drawn to an intermediate compound of a formula, classified in class 548 with several subclasses.

Group V, claims 18-19, drawn to an intermediate compound of a formula, classified in class 548 with plethora of subclasses.

Group VI, claims 23-25, drawn to a method of preparing of preparing a secondary alcohol of a formula, classified in class 568 with several subclasses.

Group VII, claims 26-28, drawn to a method of preparing a secondary ester of a formula, classified in class 558 with several subclasses.

Group VIII, claims 29-31, drawn to a method of preparing an epoxide of a formula, classified in class 549 with several subclasses.

Group IX, claims 32-33 and 36-40, drawn to a method of preparing an oxazolidinone of a formula, classified in class 548 with several subclasses.

Group X, claims 34-35, drawn to a method of preparing an oxazolidinone of a formula, classified in class 548 with several subclasses.

Group XI, claims 41-42 and 45-48, drawn to a method of preparing an oxazolidinone of a formula, classified in class 548 with several subclasses.

Group XII, claims 43-44, drawn to a method of preparing an oxazolidinone of a formula, classified in class 548 with several subclasses.

Group XIII, claims 49-50 and 53-56, drawn to a method of preparing an oxazolidinone of a formula, classified in class 548 with several subclasses.

Group XIV, claims 51-52, drawn to a method of preparing an oxazolidinone of a formula, classified in class 548 with several subclasses.

Group XV, claim 57, drawn to a method of preparing an oxazolidinone of a formula, classified in class 548 with several subclasses.

Group XVI, claims 58, drawn to a method of preparing an oxazolidinone of a formula, classified in class 548 with several subclasses.

In view of the following, the applicant requests that the restriction requirement be withdrawn.

III. Prerequisites for a Restriction Requirement

The Patent Office correctly maintains that inventions related as product and process of use can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product, or (2) the product as claimed can be used in a materially different process of using that product. MPEP §806.05(f). However, a proper basis for restriction involves four factors: distinctness, independence, classification, and burden to the Examiner. The MPEP mandates that if the search and examination of the entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. See MPEP §803.

IV. Request for Withdrawal of the Restriction Requirement

A. The Applicants traverse the restriction of claim Groups IX-XIV and XVI

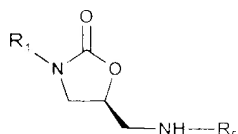
1. The Standard for Requiring Restriction Has Not Been Met Because the Criteria of Distinctiveness Has Not Been Demonstrated

The restriction requirement is improper because the criteria of distinctiveness in M.P.E.P. § 806.05(c) have not been demonstrated. The claims of Group IX-XIV and Groups IV are related as combination and subcombination. Inventions in this relationship are only distinct if it can be shown that (1) the combination claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (M.P.E.P. § 806.05(c)). The M.P.E.P. requires that "the burden is on the examiner to suggest an example of separate utility" (See M.P.E.P., §806.05(c)). The Patent Office has not even alleged (2). Thus, the standard for restricting the combination from the subcombination has not been met, and restriction should not be required (M.P.E.P. § 806.05(c)).

In addition, M.P.E.P. § 806.03 advises that:

"where the claims of an application define the same essential characteristics of a single disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth and scope of definition."

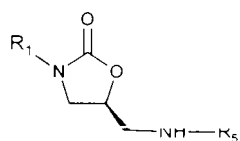
Under these requirements, the restriction between Groups IX-XIV and XVI is improper. Each of claims 32-56 is directed to a method of making an oxazolidinone compound. Independent claim 32, and its dependent claims 33, and 36-40 which are classified in Group IX, specify a method of preparing an oxazolidinone having a general structural formula:



Dependent claims 34-35, which are classified in Group X, are also directed to a method of preparing an oxazolidinone having the above formula, and more particularly

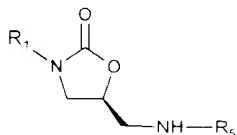
recites particular aryl substituents. Claims 34-35 are identical to claim 32, but includes the additional recitation of particular aryl substituents. The additional recitation included in claim 34-35 serves to more particularly specify the aryl substituent. Accordingly, claims 32-40 all specify method of preparing an oxazolidinone, albeit with varying breadth and scope with regards to substituents. Restriction between the claims of Groups IV and VIII, therefore, is improper.

Likewise, independent claim 41, and its dependent claims 42, and 45-48 which are classified in Group XI, specify a method of preparing an oxazolidinone having a general structural formula:



Dependent claims 43-44, which are classified in Group XII, are also directed to a method of preparing an oxazolidinone having the above formula, and more particularly recites particular aryl substituents. Claims 43-44 are identical to claim 41, but include the additional recitation of particular aryl substituents. Accordingly, claims 41-48 all specify a method of preparing an oxazolidinone, albeit with varying breadth and scope with regards substituents. Restriction between the claims of Groups XI and XII, therefore, is improper.

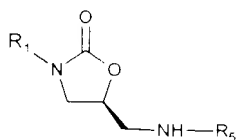
Likewise, independent claim 49, and its dependent claims 50, and 53-56 which are classified in Group XIII, specify a method of preparing an oxazolidinone having a general structural formula:



Dependent claims 51-52, which are classified in Group XIV, are also directed to a method of preparing an oxazolidinone having the above formula, and more particularly recite particular aryl substituents. Claims 43-44 are identical to claim 49, but include the additional recitation of particular aryl substituents. Accordingly, claims 49-56 all specify a

method of preparing an oxazolidinone, albeit with varying breadth and scope with regards substituents. Restriction between the claims of Groups XIII and XIV, therefore, is improper.

Finally, independent claims 58, which is classified in Group XVI, specifies a method of preparing an oxazolidinone having a general structural formula:



Independent claims 32, 41, and 49, which are classified in Groups IX, XI, and XIII, are also directed to a method of preparing an oxazolidinone having the above formula, and more particularly recite certain intermediates also recited in claim 58. Claims 32, 41, and 49 are identical to claim 58, but include only the recitation of particular intermediates. Accordingly, claims 32-56 and 58 all specify a method of preparing an oxazolidinone, albeit with varying breadth and scope with regards substituents and intermediates. Restriction between the claims of Groups IX-XIV and XVI, therefore, is improper.

Furthermore, the reasons provided in the office action for the distinctiveness of the Groups are unfounded. The office action asserts that "the process of group VI-XIV and XVI are distinct because each process has different reactive steps and conditions. Also the fields of search are not coextensive." (Office action at p. 4). With regard to the distinctiveness, as mentioned above the reactive steps and conditions of groups IX-XIV and group XVI are not distinct because they relate to each other as combination and subcombination. Group IX-XIV claims necessarily all involve the same reactive steps and conditions in their method of preparing an (S)-oxazolidinone as claim 58 of Group XVI.

With regard to the fields of search not being coextensive, the Patent Office has characterized Group IX-XIV claims as all being "drawn to a method of preparing an oxazolidinone of a formula classified in class 548 with several subclasses." (Office action at p. 3). Accordingly, the distinctions at to non-coextensive field of search alleged in the office action do not exist and, therefore, the restriction requirement is improper. For the foregoing reasons, the applicant traverses the restriction requirement on the grounds that the criteria of distinctiveness between Groups IX-XIV and XVI have not been demonstrated.

2. Lack of Reason for Insisting on Restriction

In addition to a showing of distinctiveness, the M.P.E.P. requires there to be "reasons for insisting on restriction"...i.e., separate classification, status, or field of search. (See M.P.E.P., §806.05(c), citing §808.02). Likewise, the M.P.E.P. requires that search and examination of the entire application would be a serious burden on the examiner ("If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." and "There must be a serious burden on the examiner if restriction is not required." M.P.E.P. § 803).

This additional prerequisite to restriction is especially applicable in the instant application wherein the Examiner admits that the claims of Groups IX-XIV and XVI are all classified in U.S. Class 548. While office action asserts that the "fields of search are not coextensive" this particular allegation is improper with respect to these groups of claims and, therefore, the restriction requirement is improper. Indeed, the assignment of the claims to separate Groups appears to have been based on a mischaracterization of the subject matter of these claims.

Moreover, a complete and thorough search directed to the subject matter of the claims of Group XVI will necessarily involve a search directed to the subject matter of the claims of Groups IX-XIV. The Group IX-XIV claims are combinations of Group XVI claims. The limitations recited in the independent claims of IX, XI, and XIII are elements of the Group XVI claims. All of these groups of claims are concerned with a method of preparing an (S)-oxazolidinone compound. A thorough search for Applicants' method of making an (S)-oxazolidinone (claim 58) would necessarily include within its scope a search directed to methods comprising the particular intermediates (group IX claims 32, 33, and 36-40, group XI claims 41, 42, and 45-48, and group XIII claims 49, 50, and 53-56). Accordingly, it is submitted that the claimed compounds are so closely related that all claims can be included in one search without an undue burden on the examiner and should be examined at this time. Similarly, it is submitted that oxazolidinones wherein R¹ is an optionally substituted aryl group and the substructures recited in group X, dependent claims 34-35; group XII dependant claims 43-44; and group XIV dependant claims 51-52 are likewise sufficiently related such that all recited methods could be searched simultaneously without an undue burden on the examiner. Claims readable upon the elected species include all of claims 32-56 and 58.

Because search and examination of all of the claims can be made without serious burden on the examiner, it would be wasteful of the time, effort, and resources of both the applicant and the Patent Office to prosecute the compound claims in separate applications. Search and examination of all groups of claims together would be much more efficient than requiring the Patent Office and the applicant to do so separately in 8 separate applications. The Applicants respectfully solicit the Examiner's discretion in examining the claims of Groups IX-XIV with those of Group XVI inasmuch as including the claims of Group IX-XIV in the scope of the search would not be unduly burdensome. As such, Applicants respectfully request that the restriction requirement, in respect to Groups IX-XIV and XVI, be withdrawn and these groups be examined simultaneously.

3. The Effects of the Patent Office's Position are various admissions concerning patentability

The effect of the position in the official action is that the Patent Office admits that the Group IX-XIV claims are patentable over a disclosure of the combination of Group XVI, and vice versa. M.P.E.P. § 802.01 states that the distinctness required for restriction means that the subjects, including "combination and part (subcombination) thereof ... ARE PATENTABLE (novel and unobvious) OVER EACH OTHER" (emphasis with capital letters in original). (See also M.P.E.P. § 808.02, which states that where "related inventions are not patentably distinct as claimed, restriction ... is never proper.")

Thus, the effect of this restriction requirement, unless withdrawn, is that the Patent Office admits that the claimed method of the Group IX-XIV claims is patentable over any disclosure of a compound according to the Group XVI claims. See, e.g., M.P.E.P. § 802.01. Likewise, the effect of this restriction requirement, unless withdrawn, is that the Patent Office admits that the claimed method of the Group XVI claims is patentable over any disclosure of a compound according to the Group IX-XIV claims. *Id.* Each of claims 32-56 and 58 includes similar elements, and therefore such admissions would appear to be improper.

In addition, where restriction is required, a double patenting rejection may not later be made, and therefore "it is imperative the requirement should never be made where related inventions as claimed are not distinct." M.P.E.P. § 806.

These positions are necessary to entry of the restriction requirement by the Patent Office and may be relied upon by the applicants during examination of this and

continuing applications, unless the restriction requirement is withdrawn. If the examiner is not taking these positions, then it is submitted that the restriction requirement should be withdrawn upon reconsideration.

V. Provisional Election.

To satisfy 37 C.F.R. 1.143, the applicants hereby provisionally elect for examination on the merits the claims of Group XV, which includes claim 58. This election is made *with traverse* at least for the reasons indicated above.

The Office Action further requires election of a single disclosed species. The Applicants hereby elect claims directed to the following species: the method wherein R^1 is substituted aryl and R^3 is C_1 - C_{10} alkyl; the carbamate wherein R^2 is C_1 - C_{20} alkyl; secondary alcohol wherein R^3 is C_1 - C_{10} alkyl and X is halogen; the ester wherein R^2 is C_1 - C_{10} alkyl, R^4 is C_1 - C_5 alkyl, and X is halogen; an epoxide wherein R^3 is C_1 - C_{10} alkyl. (See structural depiction of Examples 6, 7, and 8 on pages 33-35).

In doing so, the applicants do not intend to abandon the scope of the non-elected claims as originally filed, but may pursue the non-elected claims, either by petition for further review or in a divisional application, if the restriction requirement is not withdrawn upon reconsideration.

VII. Conclusion

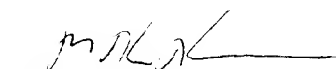
For the foregoing reasons, reconsideration and modification or withdrawal of the restriction requirement is requested. The applicants believe that the present pending claims are in condition for allowance and the applicants respectfully requests an early and favorable action on the merits.

Should the Examiner wish to discuss this response or the referenced patent application in further detail in an effort to advance this application toward allowance, the

applicants invite the Examiner to telephone or otherwise contact the undersigned.

Respectfully submitted,
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